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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,834	12/08/2000	Neil A. Willcocks	2280.2680	1867

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/731,834	Applicant(s) WILLCOCKS ET AL.	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/12/05 and 3/4/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 3/4/2005 on has been entered.

Claims 1-27, 29-40 are now pending. Claims 1, 30, 33, 36, 37, 38, 39 are independent.

Response to Arguments

2. In view of the Amendments, the previous rejections based on prior art are withdrawn and new prior art is applied (See Claim Rejections - 35 USC § 103 below).

As to the Official Noticed facts taken in the previous Office Action:

to adequately traverse a Official Noticed fact, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See MPEP 2144.03. Applicants has not traversed nor stated why the noticed facts are not considered to be common knowledge or well-known in the art. Since there was no timely and/or adequate challenge, the common knowledge or well-known in the art statements by the Examiner are taken to be admitted prior art.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

4. **Claims 1-10, 12-15, 18-27, 29-32, 35 are rejected 35 U.S.C. 103(a) as being unpatentable over “ Consumer issues in coupon usage: An exploratory analysis” by Bonnici, Joseph; Campbell, David P; Fredenberger, William B; Hunnicutt, Kathryn H, Journal of Applied Business Research v13n1 PP: 31-40 Winter 1996/1997, DIALOG(R)File 15, Record # 01370423 , herein Bonnici, in view of Laor, US 6041309.**

As to claims 1, 8, 30, 31, Bonnici discloses

A method for motivating a consumer to promptly indicate an interest in purchasing a product and/or service comprising the steps of:
presenting an offer for sale of a product and/or service to said consumer that may be purchased immediately by said consumer;

concurrently presenting to said consumer an incentive for purchasing said product and/or service promptly, wherein said incentive decreases over a period of time the incentive is initially set to be a non-zero value decreasing over time to another non-zero value different from the first non-zero value.

(see at page 8: *"This increasing trend towards offering coupons next to where the targeted products are on the retail shelves encourages instant redemption .Other creative possibilities*

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include a gradual reduction in the coupon's value over the months it takes to be redeemed, thus prodding the consumer to act quickly instead of procrastinating until about the expiration date. ...".

Bonnici does not specifically disclose an online application however Laor discloses a method for motivating a consumer to promptly indicate an interest in purchasing a product and/or service over a computer network, comprising the steps of: presenting to said consumer an offer for sale (the incentive is also an offer for sale or the instructions to complete the purchase) of a product and/or service that may be purchased immediately by said consumer via the computer network; concurrently presenting to said consumer an incentive for purchasing said product and/or service promptly,(see at least abstract, col. 2, col. 6 lines 12-30).

It would have been obvious to one skilled in the art at the time of the invention to add Laor to Bonnici to import to the online world the conveniences of brick and mortar redemption of coupons and to prod the consumer into acting quickly with the decreasing coupon as specifically disclosed by Bonnici.

As to claims 2, 32, 35 (code) (dependent on claims 1), Bonnici implicitly discloses said incentive is initially set to a predetermined maximum value. Laor discloses the technicalities of instant online redemption of incentives. The motivation for combining is the same as addressed above.

As to claim 3, Laor discloses an incentive being presented via a Web page (see at least abstract).

As to claims 4-5 (dependent on claim 1), Laor implicitly discloses presenting incentives via a window or a web banner on a Web page .

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As to claims 6-7 (dependent on claim 3), Official Notice is taken that a new offer presented when the consumer revisits or refreshes the web page is well-known. Further the new offer being a different product/service is also well-known. It would have been obvious to one skilled in the art at the time the invention was made to add these methods to the BONNICI/LAOR system to provide the consumer the opportunity to view other products and maintain her interest.

As to claims 9, 26 (dependent on claim 1) both Bonnici and Laor disclose an incentive being a discount off a purchase price (abstract).

As to claim 10 (dependent on claim 2), Bonnici implicitly discloses the incentive being a product and/or service having a variable value, from a maximum to zero at expiration date "variable discount amount over time.

As to claim 12 (dependent on claim 1), wherein a consumer who frequently uses said incentive for purchasing products and/or services is accorded a more favorable incentive than an consumer who infrequently uses said incentive to purchases goods and/or services is a matter of design choice and can not be awarded patentable weight.

As to claims 13-15 (dependent on claim 12) according the frequent consumer a higher maximum incentive, a higher minimum incentive or a longer time period for decreasing of said incentive from said maximum value down to said minimum value are all design decisions that would have been obvious to one skilled in the art at the time the invention was made because they involve very simple mathematical ways of providing a more favorable incentive once the marketer decides to provide such an incentive to the frequent consumer.

As to claims 18 (dependent on claim 1),19, 22, Laor discloses coupons targeted to user-specific data (see at least col. 1 lines 30-35).

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As to claims 20-21, (dependent on claim 19) BONNICI/LAOR does not specifically disclose but Official Notice is taken that incentive based on consumer profiles comprising location, and preferences are well-known. It would have been obvious to one skilled in the art at the time the invention was made to add those other consumer profiles factors to Barnett to enhance the marketing analysis taught in the abstract.

As to claims 23-25, Official Notice is taken that decreasing any value over a period of time gradually at a random rate, gradually and linearly as a function of time, or by fixed increments (incrementally) are well-known mathematical methods. Thus it would have been obvious to one skilled in the art at the time the invention was made to decrease the value of an incentive value from a maximum to a minimum over a period of time using the above-mentioned methods because these are well-known formulas to achieve the desired result which is to decrease the incentive value over a period of time.

As to claims 27, 29 (dependent on claim 1) , Laor discloses an incentive being a purchase price, (see at least abstract: a discounted price).

5. Claims 11, 16-17, 33-34, 36-40 are rejected 35 U.S.C. 103(a) as being unpatentable over Laor in view of Bonnici and further in view of Barnett et al., US 6336099.

As to claims 11 (dependent on claim 1) , 33-34 (code), 36 (method over computer network), 37-38 (apparatus, system), 39-40 (method via computer network) Laor does not specifically disclose but Barnett discloses (see at least col. 12 lines 8-16; col. 5 lines 35-46; Fig. 9 and associated text):
indicating an interest to purchase said product and/or service by said consumer at a point in time during said period of time; and
providing said consumer the current value of said incentive corresponding to the point in time at which said consumer indicated said interest.

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It would have been obvious to one skilled in the art at the time the invention was made to use the 'coupon variation routine' of Barnett in the BONNICI/LAOR system to change the discount amount that's decreasing over the life of the coupon as taught by Bonnici.

As to claim 16. (dependent on claim 1), BONNICI/LAOR does not specifically disclose but Barnett discloses said offer is presented for a specific number of times during a predetermined time period (see at least col.3 lines 49-50). It would have been obvious to one skilled in the art at the time the invention was made to add Barnett to the BONNICI/LAOR system to allow more exposure to the offer.

As to claim 17, The method according claim 16, wherein the presentation of said offer to a frequent consumer who frequently uses said method occurs more often is a matter of design choice and can not be awarded patentable weight.

Conclusion

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anyone of the following articles could have been used to replace Laor in the above rejections of at least claim 1.

Welcome To Search Engine, Inc. helps advertisers coupon-enable banner ads, PR Newswire, p8442, August 9, 1999, DIALOG(R)File 621, Record #02142648 discloses clicking through ads for instant purchase discounts.

MA BUYITONLINE.COM: Virtual Doors of BuyItOnline Open to the Public, Business Wire, January 26, 1999n=, DIALOG(R)File 810, Record # 0968713 BW1302 discloses offering discounts on product purchases in the virtual mall whereby shoppers instantly redeem both Web banner and print coupons online .

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EMAGINET: e-centives -- The Internet's First Free 'Personalized Savings Network' For consumers -- Launches, Business Wire, November 16, 1998, DIALOG(R)File 810, Record # 0939465 BW1390, discloses shoppers instantly redeeming their discounts online.

OneClip.com Introduces Next Generation in Online Promotions; NetGrocer, Goya Foods and Latin Grocer First To Utilize New Couponing Technology, BUSINESS WIRE, October 18, 1999, DIALOG(R)File, Record # 2007798653. discloses online merchants stimulating purchases by distributing, redeeming and clearing instant rebates, coupons and other promotions - all without having the consumer leave the retail Website.

Laor, US 6076069, discloses redeeming and clearing instant rebates, coupons and other promotions.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

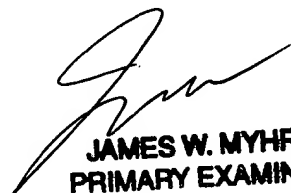
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 17, 2005

KHL

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JAMES W. MYHRE
PRIMARY EXAMINER